

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Norbert Diekhans	:	Examiner: Torres, Alicia M.
	:	
Serial No.: 09/640,126	:	Group Art Unit: 3671
	:	
Filed: August 16, 2000	:	Attorney Docket No.: 459156.83
	:	
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REGULATION	:	Confirmation No.: 4584

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTION:

Applicant's Application for Patent Term Adjustment is to receive a one thousand six hundred and thirty one (1,631) days of patent term adjustment to allowed U.S. Patent Application No. 09/640,126, which is rightfully due Applicant.

Applicant has now received the Notice of Allowance, as well as the Determination of Patent Term Adjustment. In its Determination of Patent Term Adjustment under 35 U.S.C. 154 (B), the Patent Office has not granted any patent term adjustment in the present case.

I. **Fees**

Applicant's attorney is enclosing the processing fee of \$200.00 set forth in 37 CFR §1.18(e) required for filing an application for patent term adjustment under 37 C.F.R. 1.705.

II. **Relevant Dates**

- AUGUST 16, 2000 - The present application was filed.
- JANUARY 31, 2001 – A *Non-Final Office Action* was mailed by the Patent Office, within the fourteen months deadline.
- APRIL 30, 2001 – Applicant's filed a *Response* to the *Non-Final Office Action* within three months of such *Non-Final Office Action*.
- JULY 16, 2001 – A *Final Office Action* containing a final rejection was mailed by the Patent Office, within 4 months of Applicant's *Response*. This *Final Office Action* was not received by Applicant.
- OCTOBER 17, 2001 – Application held abandoned by PTO.
- FEBRUARY 26, 2002 - *Notice of Abandonment* transmitted to Applicant.
- APRIL 23, 2002 - *Petition for Revival of an Application for Patent Abandoned Unavoidably* filed by Applicant within 2 months of transmittal of *Notice of Abandonment*.
- AUGUST 23, 2002 - Abandonment withdrawn as improper, and *Petition for Revival of an Application for Patent Abandoned Unavoidably* treated as *Petition for Withdrawal of Improper Abandonment*.
- AUGUST 23, 2002 through MARCH 28, 2008 - No action by PTO.
- MARCH 25, 2008 - *Petition to Revive* filed by Applicant.
- MARCH 28, 2008 - *Advisory Action* issued by PTO, stating that *Petition to Withdraw Improper Abandonment* lacked RCE.
- APRIL 11, 2008 - Application held abandoned by PTO.
- APRIL 28, 2008 - *Petition to Revive* denied (*Petition to Withdraw Improper Abandonment* lacked RCE).
- SEPTEMBER 29, 2008 - New *Petition to Revive* filed with RCE.
- JANUARY 27, 2009 - Application revived.

III. **Bases For Requested Patent Term Adjustment**

A. **Application Filing Date through Final Office Action - No Term Adjustment**

From the filing of the application on August 16, 2000 through the transmission of the *Final Office Action* on July 16, 2001, no patent term adjustment is appropriate. All Office Actions were filed within the time periods set forth in 37 CFR 1.703(a)(1), and Applicant's *Response* was filed within 3 months as required by 37 CFR 1.704(b).

B. **First Abandonment through Withdrawal of Abandonment - No Term Adjustment**

Applicant did not receive the *Final Office Action* transmitted on July 16, 2001. However, once Applicant received the *Notice of Abandonment* of February 26, 2002, it promptly filed a *Petition for Revival of an Application for Patent Abandoned Unavoidably* on April 23, 2002. Applicant's *Petition* was filed within 2 months of the *Notice of Abandonment*. On August 23, 2002, the abandonment was withdrawn as improper, and Applicant's *Petition for Revival of an Application for Patent Abandoned Unavoidably* was treated as a *Petition for Withdrawal of Improper Abandonment* (which was granted). As the abandonment was withdrawn as improper, no downward patent term adjustment is appropriate as per 37 CFR 1.704(c)(4).

Applicant notes that 37 CFR 1.704(c)(4), and not 37 CFR 1.704(c)(3) is inappropriate in this instance. As the MPEP notes, "the reduction in 37 CFR 1.704(c)(3) is applicable to the revival of an application properly held abandoned" (emphasis added). MPEP 2732. The application in this matter was not revived after abandonment, and instead the abandonment itself was withdrawn as improper. Indeed, as noted above, Applicant's *Petition for Revival of an Application for Patent Abandoned Unavoidably* was treated as a *Petition for Withdrawal of Improper Abandonment*. Therefore, no downward patent term adjustment is appropriate since Applicant filed its *Petition* within the 2 month period of under 37 CFR 1.704(c)(4) (which applies to improper abandonments).

C. Withdrawal of Abandonment through Advisory Action - 1922-Day Upward
Term Adjustment

In connection with its *Petition for Revival of an Application for Patent Abandoned* Unavoidably, Applicant also filed a *Response and Amendment After Final Office Action* on April 23, 2002. In its August 23, 2002 decision granting withdrawal of the abandonment withdrawal, the Office of Petitions stated "[t]he application is being returned to Technology Center 3671 for consideration of the amendment filed April 23, 2002." Decision on Petition, August 23, 2002. However, despite repeated promptings by Applicant, the PTO took no action with respect to Applicant's April 23, 2002 *Response and Amendment After Final Office Action* for **2044 days**. From August 23, 2002 through March 28, 2008, the present Application sat without action. As per 37 CFR 1.703(a)(3), Applicant's patent term should be adjusted upward these 2044 days, minus the 4 months (in this case, **122 days**) in which the Patent Office originally had to respond. As such, Applicant believes it is due an upward adjustment of its patent term by these 1922 days (2044 days - 122 days).

D. Advisory Action through Revival of Application - 291-Day DownwardTerm
Adjustment

On March 25, 2008, and prior to the PTO's issuance of the above mentioned *Advisory Action* of March 28, 2008, Applicant filed a *Petition to Revive* its application. Applicant had not received word from the Patent Office in nearly six years, and therefore filed the *Petition to Revive* with the thinking that the lack of response from the PTO may have been due to the application once again having gone abandoned. This *Petition* seems to have alerted the Patent Office to the status of the application, and an *Advisory Action* was issued three days later on March 28, 2008.

In the *Advisory Action*, the Examiner stated that the *Response and Amendment After Final Office Action* did not include a Request for Continued Examination, and set a two week deadline for filing same. Applicant, awaiting a decision as to its *Petition to Revive*, did not respond. On April 11, 2008, upon the expiration of that two week response period, the application was again held abandoned. The *Petition to Revive* was denied on April 28, 2008 for Applicant's failure to response to the *Advisory Action*.

Applicant, on September 29, 2008, then filed another *Petition to Revive* with the required RCE and the *Response and Amendment After Final Office Action* originally filed on April 23, 2002. The petition was granted and the application was revived on January 27, 2009. According to 27 CFR 1.704(c)(3)(i), a downward patent term adjustment from the abandonment of the application on April 11, 2008 through the revival of the application on January 27, 2009 is appropriate. This period totals 291 Days of downward patent term adjustment.

D. Total Patent Term Adjustment - 1,631-Days Upward Term Adjustment

Applicant submits that it is due an upward patent term adjustment of **1631 days**. This total equals the **1922 Days** of upward adjustment minus the **291 Days** of downward adjustments. Applicant calculates that the expiration date of this patent should therefore be 1631 days after August 16, 2020, or **April 4, 2025**.

VI. Terminal Disclaimer

This Patent is not subject to any terminal disclaimer that would effect the expiration date of the patent.

V. Reasonable Efforts to Conclude Processing or Examination

That there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704. On May 28, 2003, May 6, 2004, February 2, 2007 and April 9, 2007, Applicant filed status requests with the PTO regarding the status of this application. Such filings demonstrate Applicant's reasonable efforts to conclude examination of this matter.

CONCLUSION

It is respectfully believed that Applicant is due an upward patent term adjustment of **1631** days. It appears as though the file relating to this application was lost by the PTO, as there was no action by the PTO as to Applicant's *Response and Amendment After Final Office Action* from August 23, 2002 through March 28, 2008. It is respectfully believed that all of this delay was caused by the United States Patent Office.

Application of: Norbert Diekhans
U.S. Patent Application No.: 09/640,126
Application for Patent Term Adjustment

Therefore, it is respectfully requested that this Petition be granted. If a telephone conference would facilitate resolving any issue related to this Petition, the undersigned attorney would appreciate and welcome such a telephone conference. Contact information for this attorney is provided below.

Respectfully submitted,

Date:

Feb 8, 2010



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